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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/653,384
Filing Date: September 01, 2000
Appellant(s): SHOLEM, STEVEN L.

Lori F. Cuomo
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/9/08 appealing from the Office action mailed 9/18/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,550,734	TARTER et al.	8-1996
US 2002/0055858 A1	JACKSON	5-2002
5,732,401	CONWAY	3-1998

Art Unit: 3600

US 2002/0035484 A1

MCCORMICK

3-2002

5,737,539

EDELSON et al.

4-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 63, 42-51, 53-57, 60, and 64 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Tarter et al. (5,550,734) in view of Jackson (US 2002/0055858 A1), and further in view of Conway (5,732,401).

(A) Referring to claim 63, Tarter discloses a medical management system comprising at least one electronic device having (abstract of Tarter):

- a) a display (col. 19, lines 1-19 of Tarter);
- b) a memory (Fig. 10 and col. 19, lines 1-19 of Tarter); and
- c) a processor operating in accordance with software for (Fig. 10 and col. 19, lines 1-19 of Tarter):

1) receiving an identifier associated with a third party payor ("TPP") as input (col. 5, lines 53-65 of Tarter);

2) accessing data indicative of the historical payment patterns of the TPP to one or more medical service providers and assigning a rank to a patient's TPP (col. 12, lines 50-59 and col. 13, lines 10-17 of Tarter; the Examiner interprets "score and status" to be a form of "rank");

3) generating an indication of creditworthiness based at least in part upon the historical payment patterns of the TPP to the one or more medical service providers (col. 13, lines 34-60 of Tarter); and

4) generating an indication of when the TPP is accepted based in part on the rank assigned to the TPP (col. 38, lines 34-65 of Tarter);

Tarter does not disclose that a net present value of a future payment by the TPP for at least one requested medical service for a patient associated with the TPP may be generated, generating an indication of the net present value of the at least one requested medical service prior to providing the medical service, and generating an indication of when the patient's requested appointment should be scheduled based in part on the net present value and the rank assigned to the patient's TPP.

Jackson discloses generating an indication of the worth of the at least one requested medical service prior to providing the medical service (para. [0007] and [0012] of Jackson).

Conway discloses generating an indication of when the patient's requested appointment should be scheduled based in part on the cost of the procedure (col. 12, lines 50-64 and col. 14, lines 31-48 of Conway).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the aforementioned features of Jackson and Conway within Tarter. The motivation for doing so would have been to provide predictability with regard to the payment for medical services (para. [0022] of Jackson) and to enhance quality and profitability (col. 1, lines 10-17 of Conway).

While Tarter does disclose calculating a discount rate to reflect the time value of the provider's receivables (col. 40, lines 6-14 of Tarter), Tarter, Jackson, and Conway do not expressly disclose generating a *net present value* of a future payment by the TPP for at least one requested medical service for a patient. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to include the net present value of the medical service with the motivation of generating a more meaningful analysis based on the time value of money.

(B) Referring to claim 42, Tarter discloses wherein a payment pattern of the TPP comprises a time delay in payment of fees by the TPP (col. 7, lines 13-19 of Tarter).

Tarter does not expressly disclose an allowable fee schedule of the TPP and a percentage of the allowable fees paid by the TPP.

Jackson discloses an allowable fee schedule of the TPP and a percentage of the allowable fees paid by the TPP (para. [0007] and [0016] of Jackson).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the aforementioned feature of Jackson within Tarter. The motivation for doing so would have been to place a cap upon the amount the third party will pay (para. [0007] of Jackson).

(C) Referring to claim 43, Tarter does not disclose wherein a relative value for the at least one medical service is a difference between the net present value for the at least one medical service provided and a cost of providing the at least one medical service.

Jackson discloses a relative value for at least one medical service (para. [0007] of Jackson).

Conway discloses tracking the costs of medical procedures (abstract of Conway).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the aforementioned features of Jackson and Conway within Tarter. The motivation for doing so would have been to accurately account for the cost of particular services (col. 2, lines 14-21 of Conway) and to provide certainty with respect to the timing or amount of payment (para. [0013] of Jackson).

(D) Referring to claim 44, Tarter and Jackson do not disclose wherein the cost of providing the at least one medical service is a function of an equipment and supplies cost.

Conway discloses wherein the cost of providing the at least one medical service is a function of an equipment and supplies cost (abstract and col. 2, lines 46-59 of Conway).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the aforementioned feature of Conway within Tarter and Jackson. The motivation for doing so would have been to establish profitable pricing (col. 1, lines 10-13 of Conway).

Insofar as the claim recites "at least one of," it is immaterial whether or not the other elements are also disclosed.

(E) Referring to claim 45, Tarter discloses wherein the indication of the value is one of a plurality of ranked indicators (col. 13, lines 10-17 of Tarter).

(F) Referring to claim 46, Tarter, Jackson, and Conway do not disclose wherein the plurality of ranked indicators includes at least red, orange and green. The Examiner respectfully submits that presenting indicators in a user interface using colors is a well-known technique in the graphical user interface arts. The motivation for doing so would have been to allow a user to quickly ascertain information.

(G) Referring to claim 47, Tarter discloses wherein the identifier is an identifier of a patient associated with the TPP and the software is configured to generate an indication of whether it would be profitable to accept the TPP based at least in part upon the historical payment patterns of the TPP to one or more medical service providers (col. 5, lines 53-64, col. 12, lines 50-59, and col. 15, lines 54-60 of Tarter).

(H) Referring to claim 48, Tarter does not expressly disclose wherein the indication is generated as a function of the net present value of anticipated medical services to be provided for the patient.

Jackson discloses wherein the indication is generated as a function of the relative value of anticipated medical services to be provided for the patient (para. [0007] and [0012] of Jackson).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the aforementioned feature of Jackson within Tarter. The

motivation for doing so would have been to indicate the worth of the medical procedures (para. [0007] of Jackson).

- (I) Referring to claim 49, Tarter discloses wherein the indication is generated as a function of the expected profitability of the TPP (col. 15, lines 54-60 of Tarter).
- (J) Referring to claim 50, Tarter discloses wherein the software is configured to generate an indication of whether it would be profitable to enter into a services agreement with the TPP (col. 15, lines 54-60 and col. 13, lines 34-60 of Tarter).
- (K) Referring to claim 51, Tarter discloses wherein the indication is generated as a function of at least one payment pattern of the TPP (col. 12, lines 52-59 of Tarter).
- (L) Referring to claim 53, Tarter discloses wherein the indication is generated as a function of at least one payment pattern of the TPP with which the patient is associated (col. 13, lines 34-60 of Tarter).
- (M) Referring to claim 54, Tarter and Jackson do not disclose wherein the software is configured to generate a recommended duration for a primary medical personnel to visit with the patient, the recommended duration being based at least in part upon the historical payment patterns of the TPP to the one or more medical service providers.

Conway discloses wherein the software is configured to generate a recommended duration for a primary medical personnel to visit with the patient, the recommended duration being based at least in part upon the historical payment patterns of the TPP to the one or more medical service providers (col. 9, lines 46-50 and col. 1, lines 40-55 of Conway).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the aforementioned feature of Conway within Tarter and Jackson. The motivation for doing so would have been to determine the costs associated with a visitation (col. 9, lines 46-50 of Conway).

(N) Referring to claim 55, Tarter and Jackson do not disclose wherein the software is further configured to generate a timer indicating time remaining in the recommended duration.

Conway discloses wherein the software is further configured to generate a timer indicating time remaining in the recommended duration (col. 20, line 66 – col. 21, line 38 of Conway).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the aforementioned feature of Conway within Tarter and Jackson. The motivation for doing so would have been to accurately account for time (col. 20, line 66 – col. 21, line 4 of Conway).

(O) Referring to claim 56, Tarter discloses a central controller in communication with the at least one electronic device, the central controller enabling communication between a plurality of electronic devices and databases (col. 19, lines 1-19 and Fig. 10 of Tarter).

(P) Referring to claim 57, Tarter discloses wherein each of the at least one electronic device is configured as a local access terminal (col. 16, line 67 – col. 17, line 1 of Tarter).

(Q) Referring to claim 60, Tarter and Jackson do not disclose the at least one electronic device further comprising software configured to evaluate a use pattern of at least one

supply of a medical services provider, evaluate an inventory quantity of the at least one supply, evaluate an estimated scheduled appointment use of the at the least one supply, and automatically order an appropriate quantity of the at least one supply.

Conway discloses disclose the at least one electronic device further comprising software configured to evaluate a use pattern of at least one supply of a medical services provider, evaluate an inventory quantity of the at least one supply, evaluate an estimated scheduled appointment use of the at the least one supply, and automatically order an appropriate quantity of the at least one supply (col. 2, lines 46-56 and col. 11, lines 33-44 of Conway).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the aforementioned features of Conway within Tarter and Jackson. The motivation for doing so would have been to store supplies management information in order to determine when the supply must be reordered (col. 11, lines 33-44 of Conway).

(Q) Claim 64 repeats substantially the same limitations as claims 63 and 54, and is therefore rejected for the same reasons given for those claims above.

Claims 58 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tarter et al. (5,550,734) in view of Jackson (US 2002/0055858 A1), in view of Conway (5,732,401), and further in view of McCormick (US 2002/0035484 A1).

(A) Referring to claim 58, Tarter, Jackson, and Conway do not disclose wherein the at least one electronic device is configured as one of a wireless access terminal and a

wireless interface, and the at least one electronic device further comprises software configured to receive an electronic superbill and automatically send related charges to a TPP for payment.

McCormick discloses wherein the at least one electronic device is configured as one of a wireless access terminal and a wireless interface, and the at least one electronic device further comprises software configured to receive an electronic superbill and automatically send related charges to a TPP for payment (para. [0040] and [0061] of McCormick).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the aforementioned features of McCormick within Tarter, Jackson, and Conway. The motivation for doing so would have been to provide the convenience of a wireless connection (para. [0062] of McCormick), to note the diagnoses and procedures and for the insurance companies to pay the doctors according to the procedures performed (para. [0040] of McCormick).

(B) Referring to claim 59, Tarter, Jackson, and Conway do not disclose wherein the at least one electronic device is configured as one of a wireless access terminal and a wireless interface, and the at least one electronic device further comprises software configured to transmit to a pharmacy a prescription, billing information and an address to which the prescription should be delivered.

McCormick discloses wherein the at least one electronic device is configured as one of a wireless access terminal and a wireless interface, and the at least one electronic device further comprises software configured to transmit to a pharmacy a

prescription, billing information and an address to which the prescription should be delivered (para. [0061], [0073], and [0090] of McCormick).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the aforementioned features of McCormick within Tarter, Jackson, and Conway. The motivation for doing so would have been to provide the convenience of a wireless connection (para. [0062] of McCormick) and to provide the convenience of filling the order by mail (para. [0090] of McCormick).

Claim 61 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tarter et al. (5,550,734) in view of Jackson (US 2002/0055858 A1), in view of Conway (5,732,401), and further in view of Edelson et al. (5,737,539).

(A) Referring to claim 61, Tarter, Jackson, and Conway do not disclose the at least one electronic device further comprising a biometric identifying device operatively coupled thereto.

Edelson discloses at least one electronic device further comprising a biometric identifying device operatively coupled thereto (col. 17, lines 37-42 of Edelson).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the aforementioned feature of Edelson within Tarter, Jackson, and Conway. The motivation for doing so would have been a higher level of security (col. 17, lines 37-42 of Edelson).

(10) Response to Argument

In the Appeal Brief filed 9 January 2008, Appellant makes the following arguments:

A) There is no disclosure anywhere in Tarter to "generating an indication of when a patient is accepted as a new patient based in part on the net present value" and "the rank assigned to the patient's TPP," as recited in independent claims 63 and 64.

Further, there is no disclosure of "generating an indication of when the patient's requested appointment should be scheduled, based in part on the net present value" and "the rank assigned to the patient's TPP," as recited in independent claims 63 and 64. Still further, there is no disclosure in Tarter to "wherein the software is configured to generate a recommended duration for a primary medical personnel to visit with the patient, the recommended duration being based at least in part upon the historical payment patterns of the TPP to the one or more medical service providers," as recited in independent claim 64.

B) The proposed combination of Tarter, Jackson and Conway is implausible without Appellant's claims as a guide—a hindsight induced stretch to say the least. The scope and content of the prior art alone or in combination, does not meet all of Appellant's claim limitations. Accordingly, Appellant respectfully asserts that such a string of inferences pieced together to accomplish the limitations of the claims is not obvious nor motivated by the cited art, but rather stems from impermissible hindsight reasoning in light of Appellant's claimed invention.

C) With respect to claim 54, there is just no disclosure anywhere in Tarter, Jackson or Conway to the duration of a visit being based on the historical payment patterns of the TPP.

D) Tarter, Jackson and Conway are related merely as business methods in the medical field and no more. The Tarter reference, which discloses an accounts receivable management system, cannot be properly combined with Jackson and/or Conway. Conway discloses a system for tracking costs of medical procedures by monitoring the movements of personnel, supplies and equipment, and not via accounts receivable. Nor is Jackson directed to accounts receivable. Even if Tarter is modified or combined as proposed by the Examiner, the resultant modification or combination would fall short of yielding the claimed invention for failure to satisfy the claimed limitations.

Examiner will address Appellant's arguments in sequence as they appear in the brief.

Argument A:

In response to Appellant's first argument, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The Examiner respectfully submits that the rejections of claims 63 and 64 are based on the combination of Tarter,

Jackson, and Conway. In response to the limitations argued by the Appellant as not being in Tarter, the Examiner respectfully submits that she relied on Tarter for the feature of generating an indication of when the TPP is accepted based in part on the rank assigned to the TPP (col. 38, lines 34-65 of Tarter) and Conway for generating an indication of when the patient's requested appointment should be scheduled based in part on the cost of the procedure (col. 12, lines 50-64 and col. 14, lines 31-48 of Conway). The combination of Conway, Tarter, and Jackson was also relied upon for the feature of wherein the software is configured to generate a recommended duration for primary medical personnel to visit with the patient, the recommended duration being based at least in part upon the historical payment patterns of the TPP to the one or more medical service providers (col. 9, lines 46-50 and col. 1, lines 40-55 of Conway).

In response to Appellant's argument that the cited art does not teach assigning a rank, the Examiner indicated that she interprets the "score and status" in Tarter to be a form of "rank" (see col. 13, lines 10-17 of Tarter). Furthermore, while Tarter does not expressly disclose a "net present value," the Examiner did acknowledge that Tarter discloses calculating a discount rate to reflect the time value of the provider's receivables (see col. 40, lines 6-14 of Tarter). As such, it is readily apparent that the collective teachings of Tarter, Jackson, and Conway teach the aforementioned limitations of claims 63 and 64.

Argument B:

In response to Appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In addition, the Examiner respectfully submits that the claimed invention is merely a combination of old elements, and in the combination each element would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Argument C:

In response to Appellant's third argument, the Examiner respectfully submits that Conway teaches tracking the time spent on patient care activities (see col. 12, lines 50—64 of Conway). Conway is directed to producing detailed accurate cost accounting records associated with particular medical services rendered (col. 2, line 24-28 of Conway). For example, Conway teaches the cost per patient visit (see col. 9, lines 46-50 of Conway). As such, it is readily apparent that Conway is linking time and cost. Tarter discloses historical payment patterns of the TPP (col. 13, lines 34-60 of Tarter).

As such, it is readily apparent that the collective teachings of Tarter, Jackson, and Conway teach the limitations of claim 54.

Argument D:

In response to applicant's argument that Jackson and Conway are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, as acknowledged by Appellant, Jackson and Conway are business methods in the medical field. Furthermore, the references are directed to the monitoring of the cost of medical care. As such, it is respectfully submitted that Tarter, Jackson, and Conway are in the field of applicant's endeavor.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Lena Najarian/

Examiner, Art Unit 3626

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Art Unit: 3600

Page 19